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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/761,793      | 01/20/2004  | Michael James Bleau  | MB-1-CIP            | 2289             |

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| EXAMINER |
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DANG, HUNG XUAN

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2873

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                      |  |
|------------------------------|------------------------|----------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b>  |  |
|                              | 10/761,793             | BLEAU, MICHAEL JAMES |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>      |  |
|                              | Hung X. Dang           | 2873                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

### Information Disclosure Statement

1. The Information Disclosure Statement filed on 1/9/06 has been considered by Examiner.

### Claims Rejection Under 35 USC – 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-10, 12-18 and 20-24 are rejected under 35 U.S.C. 102(B) as being anticipated by **Craig** (4,122,847).

Craig discloses protective eye shield for surgical patient comprises a lens 20 adapted to cover a user's eyes, and sealing frames 28 disposed adjacent opposed lateral edges of said lens each having an adhesive side; wherein a first portion (see figures 1, 2) of said frames 28 adhesive sides is disposed along the lateral edges of the lens and a second portion 26 of the frame extends beyond the lateral edges of the lens and is adapted to conform to the shape of a user's face; wherein said frames each comprise a flexible, compliant and optionally elastic material that is adapted to conform to a user's face along said second portion and an adhesive material defining said adhesive side of said frame, wherein said lens comprises a flexible, transparent thermoplastic material (see figures 1-4 and the related disclosure.)

### Claims Rejection Under 35 USC - 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Craig** (4,122,847).

Craig discloses protective eye shield for surgical patient comprises a lens 20 adapted to cover a user's eyes, and sealing frames 28 disposed adjacent opposed lateral edges of said lens each having an adhesive side; wherein a first portion (see figures 1, 2) of said frames 28 adhesive sides is disposed along the lateral edges of the lens and a second portion 26 of the frame extends beyond the lateral edges of the lens and is adapted to conform to the shape of a user's face; wherein said frames each comprise a flexible, compliant and optionally elastic material that is adapted to conform to a user's face along said second portion and an adhesive material defining said adhesive side of said frame, wherein said lens comprises a flexible, transparent thermoplastic material (see figures 1-4 and the related disclosure.)

Craig does not teach that the lens is UV protection coating.

However, lens is tinted or UV protection coating are well known in the art of spectacles for the purpose preventing harmful radiation (ultraviolet radiation) from

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reaching the wearer's eye. Therefore, it would have been obvious to one skilled in the art to make the lens, of Craig, tinted or UV protection coating for the purpose preventing harmful radiation from reaching the wearer's eye.

### **Double Patenting Rejection**

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### **Rejection, Obviousness Type Double Patenting**

5. Claims 6-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,984,037 (Bleau). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-20 of U.S. Patent No. 6,984,037 (Bleau) anticipated claims 6-25 of this application.

Claims 1-20 of U.S. Patent No. 6,984,037 (Bleau) claiming eyewear comprising:

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a lens adapted to cover at least one of a user's eyes; and a sealing frame having an adhesive side, said frame disposed adjacent the perimeter of said lens, wherein a first portion of said adhesive side is disposed at the perimeter of said lens forming a seal between said frame and said lens and a second portion of said adhesive side extends laterally beyond the perimeter of said lens; wherein said second portion provides a means for forming a substantially airtight and water tight seal between said frame and at least a portion of the user's face adjacent the perimeter of said lens, wherein said frame comprises a flexible, compliant and optionally elastic material that is adapted to conform to a user's face along said second portion and an adhesive material defining said adhesive side of said frame wherein lens comprises a flexible, transparent thermoplastic material, wherein said lens comprises semi-rigid or rigid, transparent material and has a contour that conforms to the shape and contours of a user's face adjacent the user's eyes, wherein said lens contains at least one of an anti-fogging coating, UV protection coating, and water-shedding coating, wherein said frame contains at least one notch (see claims 1-20).

### **Response to Applicant's Argument**

6. Applicant's arguments with respect to claims 6-25 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

3/06

A handwritten signature in black ink, appearing to read 'Hung Dang', with a stylized, cursive script.

HUNG DANG

PRIMARY EXAMINER

TC 2800